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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE MAY 12 2004

APPLICANT(s): Seymour
SERIAL NO.: 08/987,995 ART UNIT: 2686
FILING DATE: 12/10/1997 EXAMINER: Mehrpour,
NaghmeH
TITLE: PORTABLE ELECTRONIC APPARATUS
ATTORNEY
DOCKET NO.: 200-007711-US (PAR)

OFFICIAL

Mail Stop Petitions
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. §1.181

I. INTRODUCTION

Applicant respectfully petitions, under 37 C.F.R. 1.181 and MPEP §1002.02(b)(3) for withdrawal of the Office Action mailed May 5, 2004 since it was issued without authorization of the Commissioner to reopen prosecution as required under 37 C.F.R. §1.198. In the event that an appropriate request to reopen prosecution was made by the Examiner and granted by the Commissioner, a new Office Action is respectfully solicited that specifically indicates such request and the authorization, and resets the statutory period for reply.

This is the second time Applicant is submitting a petition of this type and on these very same grounds. A first petition (the "First Petition") requesting withdrawal of the Office Action mailed November 20, 2003 for the same reasons described herein

was filed by facsimile on January 23, 2004. When the undersigned contacted the Examiner by telephone on March 2, 2004 to inquire as to the status of the First Petition, the Examiner indicated that there was no record of receipt of the First Petition. The First Petition was then resubmitted, via facsimile, on March 3, 2004. Copies of the First Petition and Resubmission are attached hereto as Exhibit A.

A new Office Action then issued, mailed May 5, 2004, which merely reasserts the same basis for rejection, word for word, as the Office Action mailed November 20, 2003. The Examiner does not address or even acknowledge the earlier filed First Petition. Thus, Applicant does not believe the circumstances have changed that warrant the Examiner's issuance of now another, albeit the same as the first, Office Action with a new response date, after the decision on appeal, for the reasons discussed below.

This petition is being filed pursuant to 37 C.F.R. §1.181 and MPEP §1002 within two months of the action complained of.

II. FACTS

A decision on appeal (the "Decision") by the Board of Patent Appeals and Interferences (the "Board") was mailed on March 31, 2003. A first Office Action issued by the Examiner, based on a new search, was mailed November 20, 2003 (Paper No. 19). Now, another Office Action is received, mailed on May 5, 2004, also indicated as Paper No. 19. There is no basis for the issuance of either Office Action authorization of the Commissioner to reopen prosecution as required under 37 C.F.R. §1.198. Thus, again, Applicant petitions for the withdrawal of the Office Action and allowance of the application.

III. DISCUSSION

It is respectfully submitted that both the Office Action mailed November 20, 2003 and the Office Action mailed May 5, 2004 are inappropriate and should be withdrawn since prosecution of this application after a decision on appeal has not been reopened in accordance with 37 C.F.R. §1.98. Cases decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary Examiner except under the provisions of 37 C.F.R. §1.14 or §1.196, without the written authority of the Commissioner. (37 C.F.R. §1.198). The Office Actions of November 20, 2003 and May 5, 2004 are defective, because neither indicates that authorization to reopen prosecution was requested and granted.

It was inappropriate and premature for the Examiner to conduct another search and issue a new Office Action after the Decision on Appeal. The Decision did not sustain the Examiner's rejection of claims 12 through 19 under 35 U.S.C. §103(a) as being unpatentable over Saji in view of French. This complete reversal of the Examiner's rejection brings the case up for immediate action by the Examiner. (M.P.E.P. §1214.04). However, the "Examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references." (M.P.E.P. §1214.04). Rather, the application is thus returned to the Examiner to carry into effect the decision. (37 C.F.R. §1.197). The Board did not issue any statement that would constitute a new ground of rejection of the claims. Nor did the Board include or allow a remand. (see 37 C.F.R. §1.196). Thus, more appropriately, the Examiner should have allowed this application to issue.

In order to reopen prosecution, the Examiner is required to submit the matter to the Technology (TC) Director for authorization to reopen prosecution under 37 C.F.R. §1.198 for the purpose of entering the new rejection. (M.P.E.P. §1214).

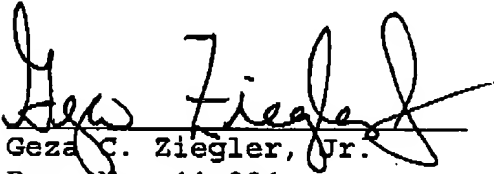
Neither the Office Action of November 20, 2003 nor the Office Action of May 5, 2004 indicates that any request was made by the Examiner to reopen prosecution after the Decision. By issuing the Office Action of May 5, 2004, the Examiner has seemingly ignored the Applicant's petition. Thus, without authorization to reopen prosecution, the issuance of both the Office Action dated November 20, 2003 and the Office Action dated May 5, 2004, is improper.

Therefore, Applicant respectfully requests that both Office Actions be withdrawn and purged from the file. In the event that authorization was granted to reopen prosecution, a new action should be issued that clearly indicates such authorization, together with a reset statutory period for reply.

Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Geza C. Ziegler, Jr.
Reg. No. 44,004

12 MAY 2004
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800 Ext. 134
Customer No.: 2512

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#44,004

EXHIBIT A
TO PETITION DATED MAY 12, 2004

08/987,995

6 pages

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(s): Seymour

SERIAL NO.: 08/987,995

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EXAMINER: Mehrpour,
Naghme

TITLE: PORTABLE ELECTRONIC APPARATUS

ATTORNEY

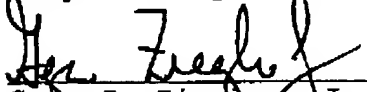
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P.O. Box 1450
Alexandria, VA 22313-1450

RESUBMISSION OF PETITION UNDER 37 C.F.R. §1.181

This petition was originally filed by facsimile on January 23, 2004. The undersigned placed a telephone call to Examiner Mehrpour on March 2, 2004 to inquire as to the status of the petition. The Examiner left me a voice mail that she has not received the petition and that there is no record of any receipt of the petition. Therefore, the petition is being resubmitted. Prompt action is respectfully solicited.

Respectfully submitted,



Gary C. Ziegler, Jr.
Reg. No. 44,004

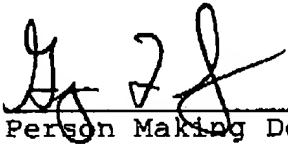
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#44004

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ART UNIT: 2686

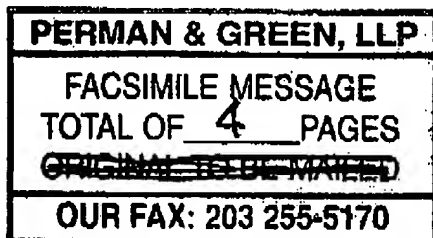
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petition is being filed pursuant to 37 C.F.R. §1.181 within two months of the action complained of.

III. DISCUSSION

It is respectfully submitted that this Office Action is inappropriate since prosecution of this application after a decision on appeal has not been reopened in accordance with 37 C.F.R. §1.98. Cases decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary Examiner except under the provisions of 37 C.F.R. §1.14 or §1.196, without the written authority of the Commissioner. (37 C.F.R. §1.198). The Office Action of November 20, 2003 is defective, because it does not indicate that authorization to reopen prosecution was requested and granted.

The Decision did not sustain the Examiner's rejection of claims 12 through 19 under 35 U.S.C. §103(a) as being unpatentable over Saji in view of French. This complete reversal of the Examiner's rejection brings the case up for immediate action by the Examiner. (M.P.E.P. §1214.04). However, the "Examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references." (M.P.E.P. §1214.04). Rather, the application is thus returned to the Examiner to carry into effect the decision. (37 C.F.R. §1.197). The Board did not issue any statement that would constitute a new ground of rejection of the claims. Nor did the Board include or allow a remand. (see 37 C.F.R. §1.196).

In order to reopen prosecution, the Examiner is required to submit the matter to the Technology (TC) Director for authorization to reopen prosecution under 37 C.F.R. §1.198 for the purpose of entering the new rejection. (M.P.E.P. §1214).

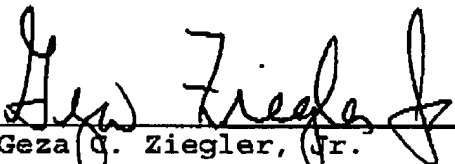
The Office Action of November 20, 2003 does not indicate that any request was made by the Examiner to reopen prosecution after the Decision. Thus, without authorization to reopen prosecution, the issuance of this Office Action dated November 20, 2003 is improper.

Therefore, Applicant respectfully requests that this Office Action be withdrawn and purged from the file. In the event that authorization was granted to reopen prosecution, a new action should be issued with a reset statutory period for reply.

Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

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Respectfully submitted,


Geza G. Ziegler, Jr.
Reg. No. 44,004

23 JANUARY 2004
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800 Ext. 134
Customer No.: 2512

BY FAX
(703) 872-9306

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